

**DOCKET NO. VERTE.032CPCCC1D**

Serial No. 10/726,774

Response to Office Action of October 7, 2004

**PATENT****Remarks**

Claims 1-11 are in the case.

***Objections to the Specification***

In paragraph 1 of the Office Action, the abstract as objected to because it was not directed to a method of a processing a thin, flat substrate, as claimed by the application. Accordingly, the Abstract is amended to properly reflect the invention claimed in the application.

In paragraph 2 of the Office Action, the title was objected to for not being descriptive of the invention. Accordingly, the title is amended to be more descriptive of the invention claimed in the application.

Thus, it is believed that the objections to the specification in paragraphs 1 and 2 of the Office Action have been overcome. It is requested that the objections be withdrawn.

***Claim Rejections Under 35 U.S.C. § 112***

In paragraphs 4 of the office Action, claims 1-11 have been rejected under 35 U.S.C. § 112, second paragraph. as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 are rejected as being incomplete because the step of processing the substrate was not recited. This rejection is improper. Claim 1 recites all of the essential steps of the invention, which include: (1) supporting the substrate in a generally horizontal orientation; and (2) transmitting sonic energy to the substrate while flowing liquid onto both sides of the substrate to loosen particles on both sides of the substrate while maintaining said orientation. The recited steps are the claimed method. It is well established in U.S. patent law that it is not necessary to recite steps that are not essential to the invention and/or known in the art. Those aspects/steps of a process that are conventional in the art need not be disclosed or claimed. See Genentech, Inc. v. Novo Nordisk, 108 F.3d 1361, 1366 (Fed. Cir. 1997). Because claims 1-4 clearly recite all of

**DOCKET NO. VERTE.032CPCCC1D****PATENT**

Serial No. 10/726,774

Response to Office Action of October 7, 2004

the steps which comprise the invention in a clear and concise manner that can be understood by those skilled in the art, the rejections is improper and should be withdrawn.

Claim 1 is rejected under 35 U.S.C. § 112 because the term "particles" in line 4 lacks clear antecedent basis. The "particles" recited in line 4 of claim 1 refers to particles that are located on the sides of the substrate itself. In fact, claim 1 clearly states that these "particles" are "on both sides of the substrate." One skilled in the art would have absolutely no problem understanding this to be the case. The rejection is improper and should be withdrawn.

Claim 2 is rejected because the term "further" should be inserted before the term "including" in line 1. Claim 2 is accordingly amended to recite further. The rejection is obviated and should be withdrawn.

Claim 3 is rejected because the term "the upper side" in line 1 lacks antecedent basis. Claim 3 is amended to change "the upper side" to "an upper side."

Claim 5 is rejected because the term "article" in line 3 lacks antecedent basis, the term "the area" at line 6 lacks antecedent basis, and the term "particles" in line 7 lacks antecedent basis. Claim 5 is amended to change "the area" to "an area" and to change the term "articles" to "article" in preamble. Thus, the antecedent rejections of "article" and "the area" are obviated. With respect to the rejection of the term "particles," the "particles" recited in line 7 of claim 5 refers to particles that are located on the one side of the article itself. In fact, claim 5 clearly states that these "particles" are "on said one side." One skilled in the art would have absolutely no problem understanding this to be the case. The rejection is improper and should be withdrawn.

Claim 6 is rejected because the term "the same time" in line 3 lacks antecedent basis. Claim 6 is amended to change "the same time" to "simultaneously."

Claims 8 and 11 are rejected because the term "the upper" in line 1 lacks antecedent basis. Claims 8 and 11 are amended to change "the upper" to "an upper."

**DOCKET NO. VERTE.032CPCCC1D****PATENT**

Serial No. 10/726,774

Response to Office Action of October 7, 2004

Claims 1-4 are also rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between steps. The omitted step being "processing substrates." As discussed above, this rejection is improper. Claim 1 recites all of the essential steps of the invention, which include: (1) supporting the substrate in a generally horizontal orientation; and (2) transmitting sonic energy to the substrate while flowing liquid onto both sides of the substrate to loosen particles on both sides of the substrate while maintaining said orientation. The recited steps are the claimed method. It is well established in U.S. patent law that it is not necessary to recite steps that are not essential to the invention and/or known in the art. Those aspects/steps of a process that are conventional in the art need not be disclosed or claimed. See Genentech, Inc. v. Novo Nordisk, 108 F.3d 1361, 1366 (Fed. Cir. 1997). Because claims 1-4 clearly recite the steps which comprise the invention in a clear and concise manner that can be understood by those skilled in the art, the rejection is improper and should be withdrawn. No gaps are present in the claim.

***Double Patenting Rejections***

In paragraphs 6-11 of the Office Action, various combinations of claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting and/or provisional obviousness-type double patenting in view of U.S. Patent No. 6,463,938, U.S. Patent No. 6,295,999, U.S. Patent No. 6,679,272, Co-Pending U.S. Application 10/760,596, and Co-Pending U.S. Application 10/059,682.

Accordingly, terminal disclaimers are being filed herewith in accordance with 37 C.F.R. § 1.321(c) for U.S. Patent No. 6,463,938, U.S. Patent No. 6,295,999, and U.S. Patent No. 6,679,272. However, applicant notes for the record that the Office Action is devoid of any reasoned statement (i.e., a John Deere analysis) to support the double patenting rejections. Nonetheless, applicant is filing the terminal disclaimer to expedite prosecution of this application.

With respect to the provisional obviousness-type double patenting in view of Co-Pending U.S. Application 10/760,596 and Co-Pending U.S. Application 10/059,682, Applicant will

**DOCKET NO. VERTE.032CPCCC1D****PATENT**

Serial No. 10/726,774

Response to Office Action of October 7, 2004

address any double patenting issues that arise at the appropriate time (i.e. after one of the applications issues as a patent).

*Claim Rejections Under 35 U.S.C. § 102*

In paragraphs 12-13 of the Office Action, claims 1 and 4 were rejected under 35 U.S.C. § 102(b) over the abstract of JP 354069260A (JP '260). The rejection is improper.

Claim 1 requires the steps of "supporting the substrate in a generally horizontal orientation; and transmitting sonic energy to the substrate while flowing liquid onto both sides of the substrate to loosen particles on both sides of the substrate while maintaining said orientation."

A review of the system and method of JP '260 does not support the substrate in a generally horizontal orientation, nor does it maintain the substrate in said horizontal orientation while flowing liquid onto both sides of the substrate, as is required by claim 1. JP '260 discloses "a rotary cleaning apparatus" where the apparatus supports an article with a rotatable support shaft. During application of liquids to the article using the 'JP '260 system, the fluid flow forces the article to vertically rotate end over end. See JP '260 Abstract. Thus, it is clear that the apparatus of JP '260 does not "transmit sonic energy to the substrate while flowing liquid onto both sides of the substrate to loosen particles on both sides of the substrate while maintaining said orientation," as is required by claim 1. In fact the Office Action does not even contend that the JP '260 does so, failing to make out a prima facie case of invalidity/anticipation.

Accordingly the rejection of claim 1 over JP' 260 is improper and must be withdrawn.

It is believed that all grounds of rejection and objection have been traversed or obviated,

**DOCKET NO. VERTE.032CPCCC1D**

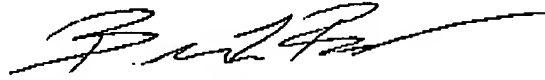
**PATENT**

Serial No. 10/726,774

Response to Office Action of October 7, 2004

and that the rejections and objection should be withdrawn, and the application allowed

COZEN O'CONNOR



BY: BRIAN L. BELLES

Reg. No. 51,322

Cozen O'Connor

The Atrium

1900 Market Street

Philadelphia, PA 19103

215 665-7244 - telephone

215 701-2044 - facsimile

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BLB/kf